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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,273	07/30/2001	Akihiko Takano	HITA.0088	7775
38327	7590	11/16/2004	EXAMINER	
REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042			HWANG, JOON H	
			ART UNIT	PAPER NUMBER
			2162	
DATE MAILED: 11/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/916,273

Applicant(s)

TAKANO ET AL.

Examiner

Joon H. Hwang

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are ~~withdrawn from consideration~~. *Cancelled*
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6/21/04.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The applicants canceled claims 1-20 and added new claims 21-28 in the amendment received on 6/23/04.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 21-28 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 21-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishioka et al. (U.S. Patent No. 6,457,004).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With respect to claim 21, Nishioka discloses a document information display means for displaying document information received as results of an initial search (lines 19-60 in col. 7, lines 30-58 in col. 9, lines 41-67 in col. 11, lines 19-24 in col. 19, fig. 3, and fig. 6). Nishioka discloses a means for selecting at least a portion of the document information displayed by the document information display means (lines 8-16 in col. 9 and fig. 33A). Nishioka discloses a search button for initiating an associative-document-type search using the at least a portion of the document information as a query (fig. 3, lines 34-58 in col. 12, lines 19-22 in col. 25, and lines 48-67 in col. 31). Nishioka discloses a means for extracting topic words from the at least a portion of the document information based on the associative-document-type search (fig. 3, fig. 6, lines 59-67 in col. 12, and lines 10-53 in col. 30). Nishioka discloses a means for modifying and confirming a Boolean expression, wherein the Boolean expression comprises the topic words (lines 19-60 in col. 7, lines 60-67 in col. 10, lines 1-7 in col. 11, lines 34-58 in col. 12, lines 19-24 in col. 19, lines 35-60 in col. 25, lines 10-53 in col. 30, fig. 3, and fig. 6).

With respect to claim 22, Nishioka discloses a document content display means for displaying the contents of documents information identified by the document

information displayed by the document information display means (fig. 3, fig. 6, fig. 27, and fig. 36).

With respect to claim 23, Nishioka discloses a database selecting part for selecting at least one database to be searched, wherein the at least one database is selected from a plurality of databases including keyword-search-type databases and associative-document-search-type databases (fig. 3, fig. 6, lines 25-60 in col. 7, lines 60-67 in col. 10, lines 31-40 in col. 11, and lines 59-64 in col. 26).

With respect to claim 24, Nishioka teaches the initial search is a keyword search (fig. 12).

With respect to claim 25, Nishioka teaches a database selecting part for selecting at least one database to be searched, wherein the at least one database is selected from a plurality of databases including keyword-search-type databases and associative-document-search-type databases and the Boolean expression is sent to at least a specified keyword-search type database selected by the database selecting part (fig. 3, fig. 6, lines 25-60 in col. 7, lines 60-67 in col. 10, lines 31-40 in col. 11, and lines 59-64 in col. 26).

With respect to claim 26, the limitations of claim 26 are similar to the limitations of claims 21, 24, and 25. Therefore, the limitations of claim 26 are rejected in the analysis of claims 21, 24, and 25 above, and the claim is rejected on that basis.

With respect to claim 27, the limitations of claim 27 are similar to the limitations of claims 21, 24, and 25. Nishioka further teaches a summary from words extracted from at least a part of a document when the at least a part of the document is specified as a

search term (lines 61-67 in col. 7, lines 1-3 in col. 8, lines 30-46 in col. 9, lines 48-56 in col. 11, lines 59-67 in col. 12, fig. 6, fig. 33A, fig. 34, and fig. 36) and sending the summary to a specified associative-document-search-type database as a query (lines 25-60 in col. 7, lines 8-16 in col. 9, lines 59-64 in col. 26, lines 10-41 in col. 30, fig. 6, fig. 34, and fig. 36). Therefore, the limitations of claim 27 are rejected in the analysis of claims 21, 24, and 25 above, and the claim is rejected on that basis.

With respect to claim 28, Nishioka teaches the document information includes a plurality of documents and the query constructing means sends a set of words as the query to the specified associative-document-search-type database, the set of words obtained by merging the summary correspondent to each of the plurality of documents (lines 25-67 in col. 7, lines 1-3 in col. 8, lines 30-46 in col. 9, lines 48-56 in col. 11, lines 59-67 in col. 12, fig. 2, fig. 6, fig. 10, fig. 27, fig. 28A, fig. 31B, fig. 34, fig. 36, and fig. 47).


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joon H. Hwang whose telephone number is 571-272-4036. The examiner can normally be reached on 9:30-6:00(M~F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Joon Hwang  
11-08-04



JEAN M. CORRIELLUS  
PRIMARY EXAMINER